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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/622,517	08/17/2000	Mitsuru Tanabe	KOIK-Q9495	8570

22850 7590 11/04/2003

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ALEXANDRIA, VA 22314

EXAMINER

HAYES, JOHN W

ART UNIT	PAPER NUMBER
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3621

DATE MAILED: 11/04/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/622,517

Applicant(s)

TANABE ET AL.

Examiner

Bradley Bayat

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 8/8/2003.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-8 and 10-13 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-8 and 10-13 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☒ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____
- 4) ☐ Interview Summary (PTO-413) Paper No(s). _____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____

DETAILED ACTION

The text of those sections of Title 35, U.S. Code not included in this section can be found in the prior office action. The prior office action dated 10 June 2003 is incorporated herein by reference. In particular, the observations with respect to claim language, and response to previously presented arguments.

Status of Claims

Claims 1-3 and 11-13 have been amended and claims 9 and 14 canceled. Therefore, claims 1-8 and 10-13 remain active and are presented again for examination on the merits.

Continued Examination Under 37 CFR 1.114

A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 8 August 2003 has been entered.

Response to Arguments

Applicant's arguments filed on August 8, 2003 have been fully considered but they are not persuasive.

Applicant asserts that the temporal data in Morito et al. is not embedded into the content, but rather stored in a database (applicant's response pg.7)." Applicant further contends "Morito et al. do not disclose prohibiting the duplication of the content if a predetermined amount of time

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has not passed since the same content was duplicated (applicant's response pg.7)." The examiner respectfully disagrees.

According to Morito et al., the embedding module obtains the copy control signal to be embedded (e.g., temporal data) from the copy control information database and embeds it into the data by applying a digital watermark (column 2, lines 8). Thereafter, the transmission module transmits the data in a conventional way with the embedded watermark. Therefore, Morito et al. does disclose the use of embedded copy control data right into the content (figure1 and associated text).

Morito et al. further discloses how duplication is prevented utilizing temporal data after the broadcast or duplication. If the resulting temporal value is greater than the predetermined value, this indicates that the attempted recording is taking place some time after the broadcast and therefore an attempt to make an unauthorized copy is prevented (column 6, lines 22-57; figure 6 and associated text).

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1-8 and 10-13 are rejected under 35 U.S.C. 103(a) as being unpatentable over Morito et al., U.S. Patent No. 6,310,956 B1 in view of Endoh, U.S. Patent No. 4,965,680.

As per claims 1-8 and 10-13, Morito et al. discloses a copy protection apparatus and method for use in digital data recorder, which includes embedding transmission time information into a digital stream by digital watermarking and comparing the transmission time with the current time. If the time difference is greater than a threshold value it is presumed that the recording is an attempted unauthorized recording such as from a pre-recorded copy, and further recording is prevented (see abstract). Morito et al. discloses an embedding module that obtains the copy control signal to be embedded from the "copy control information database" and embeds it into the data using for example, a digital watermarking technique and subsequently sends the data to the transmission module (fig 1, columns 1-4). Morito et al. does not teach the use of an International Standard Recording Code (ISRC), an identification tool used in electronic music distribution and rights administration. Endoh teaches the use of ISRC and other identifying information, i.e., table of contents for use in recording (see column 13-32). Endoh is evidence that one of ordinary skill in the art would recognize the benefit of utilizing the ISRC coding mechanism. Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the invention utilize the ISRC identification system made available primarily for such a purpose, as per teachings of Endoh et al.

Conclusion

Examiner has pointed out particular references contained in the prior arts of record in the body of this action for the convenience of the applicant. Although the specified citations are representative of the teachings in the art and are applied to the specific limitations within the individual claim, other passages and figures may apply as well. It is respectfully requested from the applicant, in preparing the response, to consider fully the entire references as

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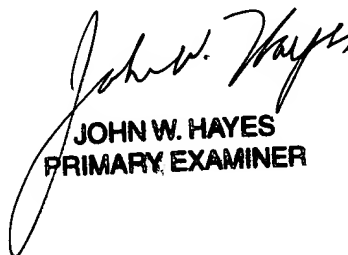
potentially teaching all or part of the claimed invention, as well as the context of the passage as taught by the prior arts or disclosed by the examiner.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Bradley Bayat whose telephone number is 703-305-8548. The examiner can normally be reached on Tuesday-Friday during normal business hours.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, James Trammell can be reached on 703-305-9768. The fax phone number for the organization where this application or proceeding is assigned is (703) 872-9306.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-306-5484.

bbb
October 17, 2003


JOHN W. HAYES
PRIMARY EXAMINER